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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/695,769

10/30/2003

Elena Grassi

Q78055

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23373

7590

10/11/2005

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EXAMINER

LAVARIAS, ARNEL C

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,769

Applicant(s)

GRASSI ET AL.

Examiner

Arnel C. Lavarias

Art Unit

2872

Am

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings were received on 8/1/05. These drawings are acceptable.

Response to Amendment

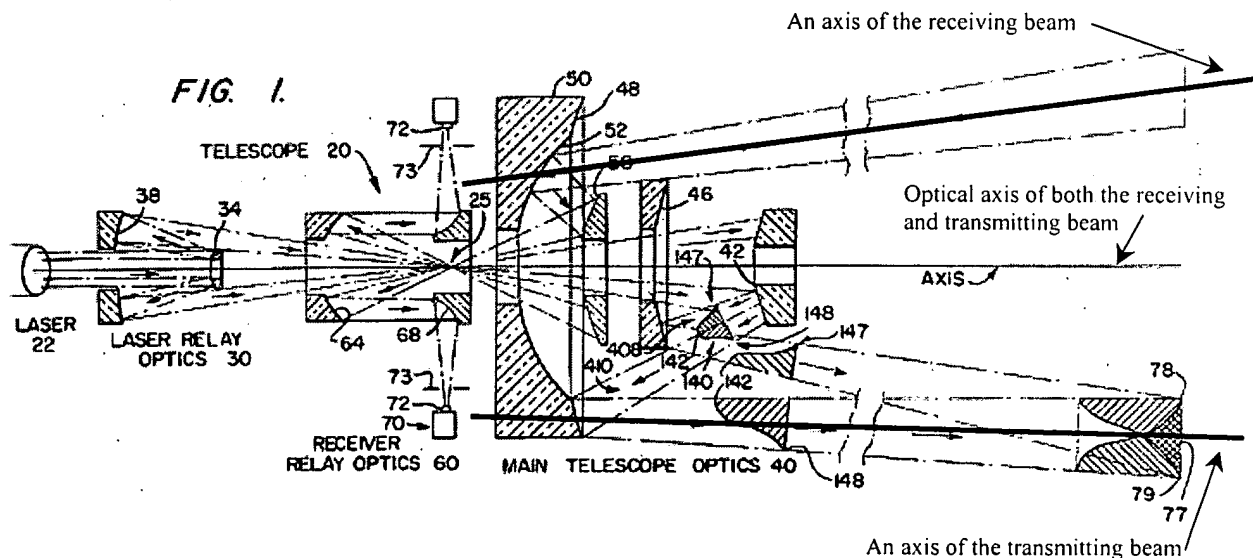
2. The amendments to the specification and abstract of the disclosure in the submission dated 8/1/05 are acknowledged and accepted. In view of these amendments, the objections to the specification in Sections 6 and 8 of the Office Action dated 5/2/05 are respectfully withdrawn.
3. The amendments to Claims 1-10 in the submission dated 8/1/05 are acknowledged and accepted. In view of these amendments, the objections to the claims in Section 9 of the Office Action dated 5/2/05 are respectfully withdrawn.
4. The addition of Claims 11-12 in the submission dated 8/1/05 is acknowledged and accepted.

Response to Arguments

5. The Applicants' arguments filed 8/1/05 have been fully considered but they are not persuasive.
6. The Applicants argue that, with respect to newly amended Claims 1 and 6, Kadrmas fails to teach or reasonably suggest the transmitting beam axis incident to the primary optical surface not coinciding with the receiving beam axis incident to the primary optical

Art Unit: 2872

surface. The Examiner respectfully disagrees. In particular, it is noted that the features upon which applicant relies (i.e., *optical* axes of both the receiver and source) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, Claim 1 and 6 only recite “the at least one transmitting beam having a corresponding axis” and “the receiving beam having an axis”. Kadrmas discloses (See Figure 1 of Kadrmas, reproduced and annotated below) the transmitting beam having an axis of propagation (one of an infinite number of axes of propagation since the transmitting beam is donut shaped). Similarly, the receiving beam has an axis of propagation (again one of an infinite number of axes of propagation since the receiving beam is also donut shaped, of which only a discrete number are detected by photosensors). Both of the particular axes shown do not coincide.



7. Claims 1-12 are now rejected as follows.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 5-8, 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kadrmas (U.S. Patent No. 3781552), of record.

Kadrmas discloses a bi-directional telescope for a laser on air telecommunication system and method for receiving-transmitting an optical signal through a bi-directional telescope for a laser on air telecommunication system (See for example Figures 1-2), both the telescope and method comprising (providing) a primary optical surface (See for example 50 in Figure 1), comprising at least one illuminated area (See for example 46, 48 in Figure 1) and a reflecting optical surface (See for example 48, 52 in Figure 1); (providing) at least one transmitting device (See for example 22 in Figure 1) forming at least one illuminated area (See for example 46, 48 in Figure 1), the at least one transmitting beam having a corresponding axis; (providing) a receiving device (See for example 72 in Figure 1) collecting the power deflected by the reflecting optical surface (See for example 52 in Figure 1) of the primary optical surface into a receiving beam, the receiving beam having an axis; wherein the reflecting optical surface of the primary

optical surface is larger than the at least one illuminated area (See 50, 48 in Figure 1) and the transmitting beam axis incident to the primary optical surface does not coincide with the receiving beam axis incident to the primary optical surface (It is noted that certain axes of both the receivers 72 and the source laser 22 are not coincident; also see Section 6 of this Office Action). Kadrmas further discloses the telescope further comprising (providing) a secondary optical surface (See for example 56 in Figure 1), wherein the received power deflected by the reflecting optical surface of the primary optical surface is focused (See for example 25 in Figure 1) by the secondary optical surface into the receiving beam; the primary optical surface comprising a hole (See for example hole in 50 of Figure 1); the secondary optical surface comprising a hole (See hole in 56 of Figure 1); the at least one transmitting device being placed fundamentally behind the reflecting optical surface (See 22, 50 in Figure 1, where 'behind' has been taken to be the locations where the reflective optical surface of element 50 does not face) and wherein the telescope further comprises means for deflecting the transmitting beam towards the secondary optical surface (See for example 38 in Figure 1); and the at least one illuminated area overlaps the reflecting optical surface (See 48, 52 in Figure 1, wherein the reflecting optical surface 48, 52 includes/overlaps that area of the surface 48 used for illumination by the source).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2872

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadrmas in view of Weiss (U.S. Patent No. 3371212), of record.

Kadrmas discloses the invention as set forth above in Claims 1-2, 6-7, except for the at least one transmitting device being placed fundamentally in front of the reflecting optical surface. However, it is well known in the art for such transmitting telescopic optical systems to place the transmitter or source either behind or in front of the reflecting face of the main reflector of the telescopic optical system. For example, Weiss teaches a conventional transmitting and receiving telescopic optical system (See Figure), wherein the transmitting optical source (See 50 in Figure) is placed in front of (i.e. in locations where the reflecting surface of the primary mirror face) the reflecting surface of the main reflector (See 12 in Figure) of the telescope. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the at least one transmitting device be placed fundamentally in front of the reflecting optical surface, as taught by Weiss, in the telescope and method of Kadrmas, for reducing the physical size of the telescope optical system, while making the source readily accessible for replacement if the source is damaged or requires replacement.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2872

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arnel C. Lavarias
10/5/05



**THONG NGUYEN
PRIMARY EXAMINER
GROUP 2800**



3/5

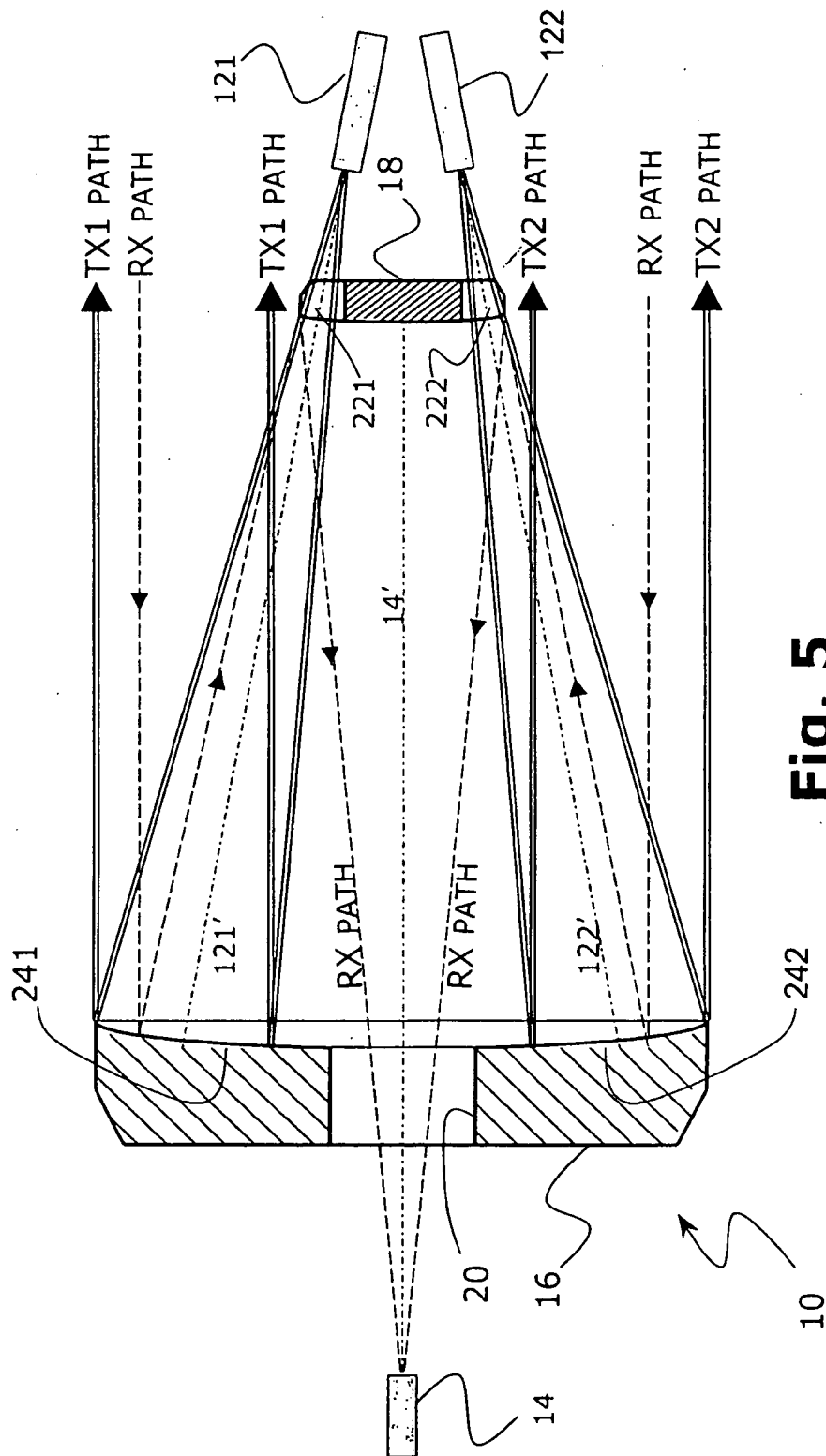


Fig. 5

*Drawing Changes
Approved
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10/4/05*